## REMARKS

In the Office Action mailed May 4, 2004, Claims 2, 5-11 and 21 are rejected under 35 U.S.C. §102(e), as being anticipated by U.S. Pat. No. 6,187,892 issued to Markusch et al. Claims 12-14, 19-22 and 25-32 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 6,187,892 issued to Markusch et al. Claims 3, 4, 23 and 24 are rejected under 35 U.S.C. §102(e), as being anticipated by, or in the alternative, under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 6,187,892 issued to Markusch et al. as applied to Claims 2 and 19.

### Rejections under 35 U.S.C. §102(e)

Claims 2, 5-11 and 21 stand rejected under 35 U.S.C. §102(e), as being anticipated by U.S. Pat. No. 6,187,892 issued to Markusch et al. Applicants respectfully disagree with the Examiner's contention regarding Markusch et al.

Applicants respectfully remind the Examiner that as stated in MPEP §2131, to anticipate a claim, a reference must teach every element of that claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ...claim." *Richardson v. Suzuki Motor Co.,* 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicants respectfully contend that the Examiner has failed to point to where Markusch et al. teach impregnating a geotextile or any textile with their polyurethane composition. According to Websters Ninth New Collegiate Dictionary, page 606 (copy attached), impregnate means to cause to be filled, imbued, permeated, or saturated. Markusch et al. state at col. 2, lines 13-16, that in their invention,

> The viscosity of the reacting adhesives is sufficiently high so that the compositions **do not soak into porous substrates and thus remain on the surface** of the substrate where they maintain their effectiveness as adhesive layers. (Emphasis added)

Thus, the disclosure of Markusch et al. does not describe the instantly claimed invention.

Therefore, Applicants respectfully request the Examiner reconsider and reverse her rejection of Claims 2, 5-11 and 21 under 35 U.S.C. §102(e), as being anticipated by U.S. Pat. No. 6,187,892 issued to Markusch et al.

**Rejections under 35 U.S.C. §103(a)**

Claims 12-14, 19-22 and 25-32 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 6,187,892 issued to Markusch et al. Applicants respectfully disagree with the Examiner's contention regarding Markusch et al.

Applicants respectfully remind the Examiner of the Federal Circuit's admonition given in *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1458-9 (Fed. Cir. 1998) that,

> To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

Applicants respectfully contend that the Examiner has failed to do so in the instant Office Action.

As stated in MPEP §2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either in the references themselves of in the knowledge generally available to one of ordinary skill in the art, citing *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992).

Clearly there is no such teaching, suggestion or motivation shown in the reference in this case to modify a polyurethane composition that will not soak into a porous surface into one which will impregnate a geotextile. If the Examiner is relying on knowledge generally available to one of ordinary skill in the art, MPEP §2144.03 states that if applicants traverse such an assertion, the Examiner should cite a reference in support of her position. Applicants do traverse the Examiner's assertion in the case and hereby request such a reference. If the Examiner is relying on facts

within her personal knowledge, applicants respectfully request and are calling for, pursuant to MPEP §2144.03 and 37 C.F.R. §1.104, the Examiner to support such facts by an Affidavit.

If the Examiner continues to maintain her rejection, applicants respectfully request she point with particularity to those portions of Markusch et al. which indicate modifying their polyurethane composition which will not soak into a porous surface into one which will impregnate a geotextile. Applicants have found no such teaching in Markusch et al. It is well established that a reference which does not recognize a problem can not suggest a solution. *In re Shaffer*, 108 USPQ 326 (CCPA 1956).

Therefore, applicants contend that nothing in the teaching of Markusch et al. would lead one of ordinary skill in the art to the instantly claimed invention and respectfully request the Examiner reconsider and reverse her rejection of Claims 12-14, 19-22 and 25-32 under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 6,187,892 issued to Markusch et al.

**Rejections under 35 U.S.C. §§102(e)/103(a)**

Claims 3, 4, 23 and 24 stand rejected under 35 U.S.C. §102(e), as being anticipated by, or in the alternative, under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 6,187,892 issued to Markusch et al. as applied to Claims 2 and 19 above. Applicants respectfully disagree with the Examiner's contention regarding Markusch et al.

As stated above in reply to the rejections under 35 U.S.C. §102(e) and under 35 U.S.C. §103(a), Markusch et al. neither teaches nor suggests a polyurethane composition capable of impregnating a geotextile.

Therefore, Applicants respectfully request the Examiner reconsider and reverse her rejection of Claims 3, 4, 23 and 24 under 35 U.S.C. §102(e), as being anticipated by, or in the alternative under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 6,187,892 issued to Markusch et al.

**Conclusion**

Applicants have amended Claims 2, 19, 21 and 32. Such amendment is to be construed as "truly cosmetic" and is not believed to narrow the scope of the claims or raise an estoppel within the meaning of *Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., et al.*, 535 U.S. 722 (2002). Applicants also contend that such claim amendments add no new matter and find support in the specification.

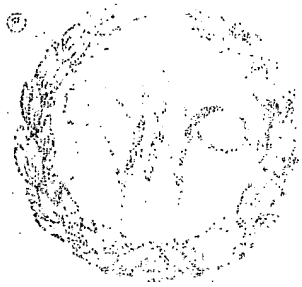
Applicants submit that the instant application is in condition for allowance. Accordingly, reconsideration and a Notice of Allowance are respectfully requested for Claims 2-14 and 19-32. If the Examiner is of the opinion that the instant application is in condition for other than allowance, she is invited to contact the Applicants' Attorney at the telephone number listed below, so that additional changes to the claims may be discussed.

Respectfully submitted,

By _____

John E. Mrozinski, Jr.
Attorney for Applicants
Reg. No. 46,179

Bayer MaterialScience LP
100 Bayer Road
Pittsburgh, Pennsylvania 15205-9741
PHONE: (412) 777-3024
FACSIMILE PHONE NUMBER:
412-777-3902
s/rmc/jem/0152



# WEBSTER'S Ninth New Collegiate Dictionary

**A GENUINE MERRIAM-WEBSTER**

The name *Webster* alone is no guarantee of excellence. It is used by a number of publishers and may serve mainly to mislead an unwary buyer.

*A Merriam-Webster*® is the registered trademark you should look for when you consider the purchase of dictionaries or other fine reference books. It carries the reputation of a company that has been publishing since 1831 and is your assurance of quality and authority.



Library of Congress Cataloging in Publication Data
Main entry under title:

Webster's ninth new collegiate dictionary.

Based on Webster's third new international dictionary.
Includes index.
1. English language—Dictionaries. I. Merriam-Webster Inc.
PE1628.W5638 1987 423 86-23801
ISBN 0-87779-508-8
ISBN 0-87779-509-6 (indexed)
ISBN 0-87779-510-X (deluxe)



Made in the United States of America

2526RMcN87

**im·preg·na·ble** \im-'preg-nə-bəl\ *adj* [ME *imprenable*, fr. MF, fr. *in-* + *prenable* vulnerable to capture, fr. *prendre* to take — more at PRIZE] (15c) **1** : incapable of being taken by assault : UNCONQUERABLE **2** : UNASSAILABLE; *also* : IMPENETRABLE — **im·preg·na·bil·i·ty** \(,)im-,preg-nə-'bil-ət-ē\ *n* — **im·preg·na·ble·ness** \im-'preg-nə-bəl-nəs\ *n* — **im·preg·na·bly** \-blē\ *adv*

**im·preg·nant** \im-'preg-nənt\ *n* (1926) : a substance used for impregnating another substance

**¹im·preg·nate** \im-'preg-,nāt, 'im-,\ *vt* **-nat·ed; -nat·ing** [LL *impraegnatus*, pp. of *impraegnare*, fr. L *in-* + *praegnas* pregnant] (1605) **1 a** : to cause to be filled, imbued, permeated, or saturated **b** : to permeate thoroughly **2** : to make pregnant : FERTILIZE *syn* see SOAK — **im·preg·na·tion** \(,)im-,preg-'nā-shən\ *n* — **im·preg·na·tor** \im-'preg-nāt-ər, 'im-,\ *n*

**²im·preg·nate** \im-'preg-nət\ *adj* (1646) : being filled or saturated

**im·pre·sa** \im-'prā-zə, -sə\ *n* [It, lit., undertaking] (1588) : a device with a motto used in the 16th and 17th centuries; *broadly* : EMBLEM

**im·pre·sa·rio** \,im-prə-'sär-ē-,ō, -'sar-, -'zär-\ *n, pl* **-ri·os** [It, fr. *impresa* undertaking, fr. *imprendere* to undertake, fr. (assumed) VL *imprehendere* — more at EMPRISE] (1746) **1** : the promoter, manager, or conductor of an opera or concert company **2** : one who puts on or sponsors an entertainment (as a television show or sports event) **3** : MANAGER, DIRECTOR

**¹im·press** \im-'pres\ *vb* [ME *impressen*, fr. L *impressus*, pp. of *imprimere*, fr. *in-* + *premere* to press — more at PRESS] *vt* (14c) **1 a** : to apply with pressure so as to imprint **b** : to produce (as a mark) by pressure **c** : to mark by or as if by pressure or stamping **2 a** : to produce a vivid impression of **b** : to affect esp. forcibly or deeply : INFLUENCE **3 a** : TRANSFER, TRANSMIT **b** : to transmit (force or motion) by pressure; *esp* : to apply (as voltage) to a circuit from an outside source ~ *vi* : to produce an impression *syn* see AFFECT

**²im·press** \'im-,pres *also* im-'\ *n* (1590) **1** : a characteristic or distinctive mark : STAMP ⟨the ~ of a fresh and vital intelligence is stamped . . . in his work —Lytton Strachey⟩ **2** : IMPRESSION, EFFECT ⟨have an ~ on history⟩ **3** : the act of impressing **4 a** : a mark made by pressure : IMPRINT **b** : an image of something formed by or as if by pressure; *esp* : SEAL **c** : a product of pressure or influence

**³im·press** \im-'pres\ *vt* [*in-* + *press*] (1596) **1** : to levy or take by force for public service; *esp* : to force into naval service **2 a** : to procure or enlist by forcible persuasion **b** : FORCE ⟨~*ed* him into a white coat for the Christmas festivities —Nancy Hale⟩

**⁴im·press** \'im-,pres *also* im-'\ *n* (1602) : IMPRESSMENT

**im·press·ible** \im-'pres-ə-bəl\ *adj* (15c) : capable of being impressed : SENSITIVE — **im·press·ibil·i·ty** \-,pres-ə-'bil-ət-ē\ *n* — **im·press·ibly** \'pres-ə-blē\ *adv*

**im·pres·sion** \im-'presh-ən\ *n* (14c) **1** : the act of impressing: as **a** : an affecting by stamping or pressing **b** : a communicating of a mold, trait, or character by an external force or influence **2** : the effect produced by impressing: as **a** : a stamp, form, or figure resulting from physical contact **b** : an imprint of the teeth and adjacent portions of the jaw for use in dentistry **c** : an esp. marked influence or effect on feeling, sense, or mind **3 a** : a characteristic, trait, or feature resulting from some influence ⟨the ~ on behavior produced by the social milieu⟩ **b** : an effect of alteration or improvement ⟨the settlement left little ~ on the wilderness⟩ **c** : a telling image impressed on the senses or the mind **4 a** : the amount of pressure with which an inked printing surface deposits its ink on the paper **b** : one instance of the meeting of a printing surface and the material being printed; *also* : a single print or copy so made **c** : all the copies (as of a book) printed in one continuous operation from a single makeready **5** : a usu. indistinct or imprecise notion or remembrance **6 a** : the first coat of color in painting **b** : a coat of paint for ornament or preservation **7** : an imitation or representation of salient features in an artistic or theatrical medium; *esp* : an imitation in caricature of a noted personality as a form of theatrical entertainment *syn* see IDEA

**im·pres·sion·able** \im-'presh-(ə-)nə-bəl\ *adj* (1836) : capable of being easily impressed — **im·pres·sion·abil·i·ty** \-,presh-(ə-)nə-'bil-ət-ē\ *n*

**im·pres·sion·ism** \im-'presh-ə-,niz-əm\ *n* (1882) **1** *often cap* : a theory or practice in painting esp. among French painters of about 1870 of depicting the natural appearances of objects by means of dabs or strokes of primary unmixed colors in order to simulate actual reflected light **2 a** : the depiction of scene, emotion, or character by details intended to achieve a vividness or effectiveness more by evoking subjective and sensory impressions than by recreating an objective reality **b** : a style of musical composition designed to create subtle moods and impressions

**im·pres·sion·ist** \im-'presh-(ə-)nəst\ *n* (1881) **1** *often cap* : one (as a painter) who practices or adheres to the theories of impressionism **2** : an entertainer who does impressions

**im·pres·sion·is·tic** \(,)im-,presh-ə-'nis-tik\ *adj* (1886) **1** *or* **im·pres·sion·ist** \im-'presh-(ə-)nəst\ : of, relating to, or constituting impressionism **2** : based on or involving impression as distinct from knowledge or fact ⟨intuitions and ~ anecdotal accounts —Sidney Hook⟩ — **im·pres·sion·is·ti·cal·ly** \(,)im-,presh-ə-'nis-ti-k(ə-)lē\ *adv*

**im·pres·sive** \im-'pres-iv\ *adj* (1598) : making or tending to make a marked impression *syn* see MOVING — **im·pres·sive·ly** *adv* — **im·pres·sive·ness** *n*

**im·press·ment** \im-'pres-mənt\ *n* (1787) : the act of seizing for public use or of impressing into public service

**im·pres·sure** \im-'presh-ər\ *n, archaic* (1600) : a mark made by pressure : IMPRESSION

**im·prest** \'im-,prest\ *n* [obs. *imprest* (to lend), prob. fr. It *imprestare*] (1568) : a loan or advance of money

**im·pri·ma·tur** \,im-prə-'mä-,tù(ə)r, im-'prim-ə-,t(y)ù(ə)r\ *n* [NL, let it be printed, fr. *imprimere* to print, fr. L, to imprint, impress — more at IMPRESS] (1640) **1 a** : a license to print or publish esp. by Roman Catholic episcopal authority **b** : approval of a publication under circumstances of official censorship **2 a** : SANCTION, APPROVAL **b** : IMPRINT **c** : a mark of approval or distinction

**im·pri·mis** \im-'pri-məs, -'prē-\ *adv* [ME *imprimis*, fr. L *in primis* among the first (things)] (15c) : in the first place — used to introduce a list of items or considerations

**¹im·print** \im-'print, 'im-,\ *vt* (14c) **1** : to mark by or as if by pressure : IMPRESS **2 a** : to fix indelibly or permanently (as on the memory) **b** : to subject to or induce by imprinting ⟨an ~*ed* preference⟩ **c** : to undergo imprinting — **im·print·er** \-ər\ *n*

**²im·print** \'im-,print\ *n* [MF *empreinte*, fr. fem. of *empreint*, pp. of *preindre* to imprint, fr. L *imprimere*] (15c) : something imprinted: as **a** : a mark or depression made by pressure ⟨the fossilized ... of a dinosaur's foot⟩ **b** : an identifying name (as of a publisher) placed conspicuously on a product (as at the foot of the title page of a book) *also* : the name under which a publisher issues books **c** : an indication distinguishing effect or influence

**im·print·ing** \'im-,print-iŋ, im-'\ *n* (ca. 1937) : a rapid learning process that takes place early in the life of a social animal (as a greylag goose) and establishes a behavior pattern (as recognition of and attraction to its own kind or a substitute)

**im·pris·on** \im-'priz-ᵊn\ *vt* [ME *imprisonen*, fr. OF *emprisoner*, fr. *en-* + *prison* prison] (14c) : to put in or as if in prison : CONFINE — **im·pris·on·able** \-'priz-ᵊn-ə-bəl, -'priz-nə-\ *adj* — **im·pris·on·ment** \im-'priz-mənt\ *n*

**im·prob·a·ble** \(ᵊ)im-'präb(-ə)-bəl\ *adj* [MF or L; MF, fr. L *improbabilis*, fr. *in-* + *probabilis* probable] (1598) : unlikely to be true or to occur *also* : unlikely but real or true — **im·prob·a·bil·i·ty** \(,)im-,präb-ə-'bil-ət-ē\ *n* — **im·prob·a·bly** \(ᵊ)im-'präb(-ə)-blē\ *adv*

**¹im·promp·tu** \im-'präm(p)-(,)t(y)ü\ *n* [F, fr. *impromptu* extemporaneously, fr. L *in promptu* in readiness] (1683) **1** : something that is impromptu **2** : a musical composition suggesting improvisation

**²impromptu** *adj* (1764) **1** : made, done, or formed on or as if on the spur of the moment : IMPROVISED **2** : composed or uttered without previous preparation : EXTEMPORANEOUS — **impromptu** *adv*

**im·prop·er** \(ᵊ)im-'präp-ər\ *adj* [ME *improper*, fr. L *improprius*, fr. *in-* + *proprius* proper] (15c) : not proper: as **a** : not in accord with fact, truth, or right procedure : INCORRECT ⟨~ inference⟩ **b** : not regularly or normally formed or not properly so called **c** : not suited to the circumstances, design, or end ⟨~ medicine⟩ **d** : not in accord with propriety, modesty, good manners, or good taste *syn* see INDECOROUS — **improper fraction** *n* (1542) : a fraction whose numerator is equal to, larger than, or of equal or higher degree than the denominator — **improper integral** *n* (ca. 1942) : a definite integral whose region of integration is unbounded or includes a point at which the integrand is undefined or tends to infinity — **im·prop·er·ly** *adv* — **im·prop·er·ness** *n*

**im·pro·pri·ety** \,im-p(r)ə-'pri-ət-ē\ *n, pl* **-eties** [F or LL; F *impropriété*, LL *impropriatē-, improprietas*, fr. L *improprius*] (1611) **1** : the quality or state of being improper **2** : an improper or indecorous act or remark; *esp* : an unacceptable use of a word or of language

**im·prov·able** \im-'prü-və-bəl\ *adj* (1646) : capable of improving or being improved — **im·prov·abil·i·ty** \-,prü-və-'bil-ət-ē\ *n* — **im·prov·ably** \-'prü-və-blē\ *adv*

**im·prove** \im-'prüv\ *vb* **im·proved; im·prov·ing** [AF *emprouer* to invest profitably, fr. OF *en-* + *prou* advantage, fr. LL *prode* — more at PROUD] *vt* (15c) **1 a** : to enhance in value or quality : make better **b** : to increase the value of (land or property) by betterment (as cultivation or the erection of buildings) **c** : to grade and drain (a road) and apply surfacing material other than pavement **2** *archaic* : EMPLOY, USE **3** : to use to good purpose ~ *vi* **1** : to advance or make progress in what is desirable **2** : to make useful additions or amendments — **im·prov·er** *n*

**im·prove·ment** \im-'prüv-mənt\ *n* (15c) **1** : the act or process of improving **2 a** : the state of being improved; *esp* : enhanced value or excellence **b** : an instance of such improvement : something that enhances value or excellence

**im·prov·i·dence** \(ᵊ)im-'präv-əd-ən(t)s, -ə-,den(t)s\ *n* (15c) : the quality or state of being improvident

**im·prov·i·dent** \-əd-ənt, -ə-,dent\ *adj* [LL *improvident-, improvidens*, fr. *in-* + *provident-, providens* provident] (1514) : not provident : not foreseeing and providing for the future — **im·prov·i·dent·ly** *adv*

**im·pro·vi·sa·tion** \(,)im-,präv-ə-'zā-shən, ,im-prə-və- *also* ,im-prə-(,)vī-\ (1786) **1** : the act or art of improvising **2** : something (as a musical or dramatic composition) improvised — **im·pro·vi·sa·tion·al** \-shnəl, -shən-ᵊl\ *adj* — **im·pro·vi·sa·tion·al·ly** \-ē\ *adv*

**im·prov·i·sa·tor** \im-'präv-ə-,zāt-ər\ *n* (1795) : one that improvises — **im·prov·i·sa·to·ri·al** \(,)im-,präv-ə-zə-'tōr-ē-əl, -'tór-\ *adj* — **im·pro·vi·sa·to·ry** \im-'präv-ə-zə-,tōr-ē, ,im-prə-'vī-zə-, -,tór-\ *adj*

**im·pro·vi·sa·to·re** \(,)im-,präv-ə-zə-'tōr-ē, ,im-prə-,vē-zə-, -'tór-\ *n, pl* **-to·ri** \-'tōr-ē, -'tór-\ *or* **-tores** [It *improvvisatore*, fr. *improvvisare*] (ca. 1765) : one that improvises (as verse) usu. extemporaneously

**im·pro·vise** \,im-prə-'vīz, 'im-prə-,\ *vb* **-vised; -vis·ing** [F *improviser*, fr. *improvviso* sudden, fr. L *improvisus*, lit., unforeseen, fr. *in-* + *provisus*, pp. of *providēre* to see ahead — more at PROVIDE] *vt* (1826) **1** : to compose, recite, play, or sing extemporaneously **2** : to make, invent, or arrange offhand **3** : to fabricate out of what is conveniently on hand ~ *vi* : to improvise something — **im·pro·vis·er** *or* **im·pro·vi·sor** \-'vī-zər, -,vī-\ *n*

**im·pru·dence** \(ᵊ)im-'prüd-ᵊn(t)s\ *n* (15c) **1** : the quality or state of being imprudent **2** : an imprudent act

**im·pru·dent** \-ᵊnt\ *adj* [ME, fr. L *imprudent-, imprudens*, fr. *in-* + *prudent-, prudens* prudent] (14c) : not prudent : lacking discretion — **im·pru·dent·ly** *adv*

**im·pu·dence** \'im-pyəd-ən(t)s\ *n* (14c) : the quality or state of being impudent

**im·pu·dent** \-ənt\ *adj* [ME, fr. L *impudent-, impudens*, fr. *in-* + *pudent-, pudens*, prp. of *pudēre* to feel shame] (14c) **1** *obs* : lacking modesty **2** : marked by contemptuous or cocky boldness or disregard of others : INSOLENT — **im·pu·dent·ly** *adv*

**im·pu·dic·i·ty** \,im-pyü-'dis-ət-ē\ *n* (1528) : lack of modesty : SHAMELESSNESS

**im·pugn** \im-'pyün\ *vt* [ME *impugnen*, fr. MF *impugner*, fr. L *inpugnare*, fr. *in-* + *pugnare* to fight — more at PUGNACIOUS] (14c) **1** *obs* **a** : ASSAIL **b** : RESIST **2** : to assail by words or arguments : oppose or attack as false or lacking integrity — **im·pugn·able** \-'pyü-nə-bəl\ *adj* — **im·pugn·er** \-nər\ *n*

**im·puis·sance** \(ᵊ)im-'pwis-ᵊn(t)s, (ᵊ)im-'pyü-ə-sən(t)s; ,im-pyü-'is-ᵊn(t)s\ *n* [ME, fr. MF, fr. *in-* + *puissance* puissance, power] (15c) : WEAKNESS, POWERLESSNESS

**im·puis·sant** \-ᵊnt, -sənt\ *adj* [F] (1629) : WEAK, POWERLESS